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D-1108

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	**David T. Frederick**	)	Art Unit: **3653**
Serial No.:	**09/288,685**	)	
Confirm. No.:	**7773**	)	
Filed:	**April 9, 1999**	)	Patent Examiner: **Jeffrey A. Shapiro**
Title:	**Medical Cabinet With Adjustable Drawers**	)	

Office of the Deputy Commissioner for Patent Examination Policy
Box DAC
Commissioner for Patents
Washington, D.C. 20231

Sir:

Petition To Review A Decision Of A Technology Center Director

Appellant respectfully requests that the ruling in the Decision dated March 21, 2003 be reviewed and reversed. Appellant also respectfully requests a withdrawal of the holding of abandonment.

Overview of dates and papers associated with this application

1.	04/09/99	Initial filing
2.	08/17/00	Office Action (first) rejection
3.	11/10/00	Response by Appellant (successfully traversing the rejection)
4.	02/12/01	Office Action first restriction requirement
5.	03/01/01	Response by Appellant (successfully traversing the first restriction)
6.	05/22/01	Office Action second (different) restriction requirement
7.	06/04/01	Response by Appellant (successfully traversing the second restriction)
8.	07/17/01	Office Action (second non final) rejection
9.	10/17/01	Notice of Appeal
10.	12/17/01	Appeal Brief
11.	03/05/02	Notice of Noncompliant Appeal Brief (with one month reply period)
12.	03/14/02	Appeal Brief
13.	05/02/02	Petition for Withdrawal of Holding of Noncompliant Appeal Brief
14.	07/11/02	Notice of Noncompliant Appeal Brief (with one month reply period)
15.	08/28/02	Petition for Withdrawal of Holding of Noncompliant Appeal Brief
16.	03/21/03	Decision on Petitions
17.	03/26/03	Notice of Abandonment

Appellant respectfully disagrees with the March 21, 2003 Decision on petitions for Withdrawal of Holding of Noncompliance with 37 C.F.R. § 1.192(c) ("Decision"). Appellant respectfully submits that the appeal to the Board of the decision of the Primary Examiner, mailed July 17, 2001 remains pending. The rejections in the Office Action dated July 17, 2001 are the

only legal rejections pending. Appellant's submitted a signed Appeal Brief in response to the pending rejections. Prosecution has never been reopened.

There was no statement in the Office Action dated March 5, 2002 notifying Appellant that prosecution was reopened. Nor was the Office Action dated March 5, 2002 in compliance with the procedural rules of the Office (MPEP § 1208.02) for reopening prosecution. Furthermore, in imposing requirements directly contrary to any reopening of prosecution, the Office Action dated March 5, 2002 required (in the Notice of Noncompliant Appeal Brief) Appellant to submit a signed copy of the Appeal Brief originally filed December 17, 2001, and set a one month time period for reply. The Notice of Noncompliant Appeal Brief is further evidence that prosecution was never reopened. If Appellant's Appeal Brief was not in effect (active), then why would the Office require a signed copy thereof? Appellant does not know the basis of the extraneous comments referencing non-pending rejections in the Office Action dated March 5, 2002. Perhaps the comments were miscopied therein from another application. However, the extraneous comments are not in effect (active). These extraneous comments in the Office Action dated March 5, 2002 are not the pending rejections in the record. The extraneous comments are also non responsive to Appellant's Appeal Brief. Furthermore, the Office cannot simultaneously require responses to both a Notification of Non-Compliance with 37 C.F.R. § 1.192(c) ("Notice") and extraneous comments not related to the appeal, and then hold the application abandoned for failing to respond to the extraneous comments.

The Office Action dated March 5, 2002 was defective. Appellant, in the Response dated March 14, 2002, called to the attention of the Office the defects. Appellant also stated (on page 2 of the Response) that the Action was defective. Thus, Appellant properly notified the Office of

the errors within one month, in compliance with MPEP § 710.06. The Office is required to restart the period for reply to run from the date the error is corrected. However, the errors in the Office Action dated March 5, 2002 still have not been corrected. Rather, additional errors by the Office have been committed.

The Decision states that "On March 5, 2002 the examiner found the Brief defective because it was unsigned and concurrently gave applicants a new non-final rejection." The Decision fails to mention that Appellant was required to submit another Appeal Brief. For example, the Office Action dated March 5, 2002 states (on page 2) that "A ratification properly signed is required" and "To avoid dismissal of the appeal, appellant must ratify the appeal brief." The Office Action further set a time period of one month for Appellant to resubmit the Appeal Brief. That is, Appellant was not afforded another response option (for example there was no basis to file a reply under 37 C.F.R. § 1.111 or request reinstatement of the appeal (MPEP § 1208.02)). Appellant had to ratify the previously submitted Appeal Brief, otherwise the application would be held abandoned. Appellant did so. Again, prosecution was never reopened, which the Decision also fails to mention. The Decision further fails to mention that the rejections addressed in the Appeal Brief were the actual pending rejections of record, not the allegedly new non-final rejections.

Because of the requirement to Appellant to resubmit the Appeal Brief (i.e., respond to the appealed rejections), the allegedly new non-final rejections are merely extraneous comments. That is, because of the requirement imposed on Appellant to resubmit the Appeal Brief in response to the appealed rejections, prosecution could not have been reopened. The imposed Appeal Brief requirement (and the appealed rejections pertaining thereto) would first have to be

vacated before prosecution could be reopened. Such was not the action of the Office. The Office's requirement for Appellant to resubmit the Appeal Brief is *prima facie* evidence that prosecution was never reopened. Since prosecution was never reopened, the alleged new non-final rejections were never pending. The appealed rejections were pending, and take precedence.

The Office cannot legally require an Appeal Brief in response to an appealed set of rejections on one hand, and also simultaneously reopen prosecution with a different set of rejections on the other hand. The Office cannot mail a Notification of Non-Compliance with 37 C.F.R. § 1.192(c) requiring an Appellant to resubmit an Appeal Brief in response to an appealed set of rejections, wherein the Notification has inserted therein extraneous comments without reopening prosecution, and then hold the application abandoned due to the extraneous comments.

Nor can the Office impose two concurrent different sets of prosecution requirements, and then pick and choose which set of prosecution requirements to maintain based on Appellant's response. If Appellant did not refile the Appeal Brief of March 14, 2002 (which the Action dated March 5, 2002 required), then the Office would have held the application abandoned. Appellant also takes exception to the rejection dated July 11, 2002 which was made final in response to the request for clarification. Instead of clarifying the record and correcting the defective Office Action of March 5, 2002, including restarting the time for response, the next action was made final. Clearly, the final rejection dated July 11, 2002 is premature. Appellant further request that the premature final rejection be vacated.

Prosecution has never been reopened. Appellant's Appeal Brief filed March 14, 2002 is in compliance with 37 C.F.R. § 1.192(c) and remains pending. All of the Office Actions

subsequent to the Appeal Brief (filed March 14, 2002) are non responsive to the properly pending Appeal Brief.

Appellant respectfully submits that the ruling in the Decision is in error because it was incorrectly based on rejections (i.e., the alleged new non-final rejections) that were not legally pending. Appellant respectfully requests that the ruling be reversed. Furthermore, it is improper to hold an application abandoned based on alleged rejections which are neither pending nor of record. Such is the present situation. Thus, Appellant also respectfully requests a withdrawal of the holding of abandonment. Appellant further requests that either (1) the application be remanded to the Director for a decision on the petition filed August 28, 2002 regarding the issue of appeal brief size limit (whereof the Office has previously granted petitions on the issue), or (2) the Office Action dated May 2, 2002 be treated as an Examiner's Answer in response to the active and pending Appeal Brief filed March 14, 2002.

Request for Refund

As previously discussed, Appellant respectfully submits that the application is not abandoned. Nevertheless, an Appellant, due to compliance with time requirements, is not permitted a delay in filing a petition under 37 C.F.R. § 1.137 (MPEP 711.03(c)). Thus, Appellant was required to file a revival petition under 37 C.F.R. § 1.137(b) and pay the corresponding petition fee (37 C.F.R. § 1.17(m)). Appellant respectfully submits that with the grant of the petition presented herein, the revival petition fee would have been paid when no fee was required. Therefore, upon grant of the petition to Review a Decision of a Technology Center

Director presented herein, Appellant requests a refund of the paid revival petition fee (37 C.F.R. § 1.17(m)) and any other unnecessary paid fee.

Conclusion

Appellant's petition should be granted for the reasons presented herein. The undersigned will be happy to discuss any aspect of the application by telephone at the Office's convenience.

Respectfully submitted,

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